

## REMARKS

Reconsideration of the application is respectfully requested for the following reasons:

1. Formalities

The objection to the specification, set forth on page 6 of the Official Action, has been addressed by amending page 5, line 15 of the specification to refer to Figs. 6 and 7 rather than Figs. 5 and 6, and by amending page 6, line 20 of the specification to refer to Fig. 11 rather than Fig. 14.

The objection the drawings for failing to show contact with a human chest as recited in claim 1 has been addressed by amending claim 1 to recite contact with a human body (which is shown in Figs. 17-20) rather than a human chest.

2. Rejection of Claims 1-10, 12, and 14 Under 35 USC §101

This rejection has been addressed by amending claims 1 and 2 to recite that the plates are –adapted to be– in direct contact with the human body, as suggested by the Examiner, rather than in direct contact as originally claimed.

3. Rejection of Claims 1-10, 12, and 14 Under 35 USC §112, 2nd Paragraph

This rejection has been addressed by:

- a. amending each of the claims to delete the recitation of “medium and low frequency” massaging effects;
- b. amending claims 3 and 9 to more positively recite the elastic waistband;
- c. amending claim 6 to depend from claim 4, and by amending claim 4 to positively recite pulsed voltages;
- d. amending claim 7 to delete the “is installed” phraseology; and
- e. amending claims 11 and 12 to delete the “are mounted” phraseology.

4. Rejections of Claims 1-18 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,151,528 (Maida), 4,148,321 (Wyss), and 6,210,771 (Post)

These rejections are respectfully traversed on the grounds that none of the references cited by the Examiner in item 1 on page 4 of the Official Action discloses or suggests pants with conductive plates and strips, and in particular pants with **clustered** buttons that not only connect the conductive strips and a controller, but that also **mount the controller** by enabling the controller to either be plugged directly into the buttons, as illustrated in Fig. 1 and recited in claim 1. The clustered buttons provide a convenient way of connecting the strips with the controller, thereby avoiding the extended wires 20-22 used in the pants of Maida, and also eliminate the need for a separate controller mounting means..

The claimed invention involves pants in which the electro-stimulating plates are connected to the controller by strips arranged to enable button terminals to be clustered, *and thereby used to mount the controller*. The arrangement may be summed up as plates ⇒ strips ⇒ clustered buttons ⇒ controller. The clustering of the buttons enables the buttons 12 to be mounted or “plugged” directly into corresponding buttons 23 on the controller, as illustrated in Fig. 1.

Page 4, lines 19-23 of the original specification specifically describes clustering of the conductive buttons 12 so that they can be coupled with a corresponding set of conductive buttons 23 on the controller 2 “*so as to mount the controller 2 onto the pants 10.*” As a result, amendment of the claims to recite clustering of the buttons to mount the controller does not involve **new matter**.

In contrast, the Maida patent discloses plates 13-15 ⇒ terminals 17-19 ⇒ conductors (wires) 20-21 ⇒ generator (controller) 12. Unlike the claimed invention, there is no clustering of “buttons.” To the contrary, wires 20-21, which are between the plates 13-15 and “controller” 12, extend all the way from one side of the pants to the other and cannot possibly be considered to be clustered, while terminals 17-19 are both scattered and connected directly to the plates, and

therefore also cannot possibly correspond to the claimed buttons. Furthermore, the generator/controller of Maida is mounted by means other than buttons that connect the controller to the plates.

The Wyss patent does not make up for the deficiencies of the Maida patent since the Wyss patent does not teach any sort of garment, much less a pants of the type claimed with conductive plates, strips, and clustered buttons that electrically connect and mount the controller, as claimed. The Post patent is directed to electro-stimulating textiles and provides no suggestion of including the textiles in pants, much less a suggestion of including conductive strips and clustered buttons, as claimed.

Since none of the references suggests the claimed arrangement of conductive plates, strips, and clustered buttons, it is respectfully submitted that the combination proposed by the Examiner could only have been made in hindsight. The Examiner is reminded that, as explained in *In re Fritch*, 23 USPQ2d 1780,1783 (Fed. Cir. 1992):

*'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so [quoting ACS Hosp. Systems, Inc. v. Montefiore Hosp., 221 USPQ 929,933 (Fed. Cir. 1984)].' Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.*

It is true that the massager disclosed in the Maida patent *could* have been adapted to include conductive plates, strips, and clustered buttons that electrically connect and mount the controller, but there is no suggestion in the Maida patent or any of the other references of record, whether considered individually or in any reasonable combination, to do so. Consequently, withdrawal of the rejections under 35 USC §103(a) is respectfully requested.

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Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC

A handwritten signature in black ink, appearing to be 'B. Urcia', with a long horizontal flourish extending to the right.

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